

0/20/88

R-1988-3

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re)	Decision on Petition
Petitioner)	for Review under
_____)	Rule 10.2(c)

, hereinafter petitioner, requests review under 37 CFR 10.2(c) of the Decision on Request for Regrade on the Afternoon Section of the Examination Held on October 6, 1987, which was rendered on March 31, 1988 by the Director of the Office of Enrollment and Discipline (OED), hereinafter Director. Petitioner seeks an award of twenty two additional points to his score.

BACKGROUND

Petitioner took the examination for registration to practice before the Patent and Trademark Office on October 6, 1987. He previously passed the morning section but received less than the minimum 70 points (out of 100) on the afternoon part necessary to be registered. A request for regrading on questions 1, 3 and 4 was received on February 26, 1988. In his decision on the request, the Director added no points for question 1, 2 points for question 3 and 5 points for question 4, which resulted in a total score of 65 points. On April 29, 1988, this petition was received which requests an increase of 4 points on question 1 and 18 points on question 3.

FACTUAL REVIEW

Question 1

This question asked the examinees to prepare a single claim on either a folding tooth brush or an electrical device. Petitioner chose the former.

The initial grader deducted 11 points (out of 20). On review, the Director did not add any points. Petitioner argues that the deduction of 2 points for failing to provide antecedent basis for the term "the unhinged end" in element (g) of his claim was improper because that term was recited as part of element (e). Also, he asserts that the term "side walls" is not indefinite as determined by the grader and the Director and therefore the deduction of one point was not appropriate. Finally, he questions the 1 point deduction for vagueness in the recitation of element (c) which described the handle of the brush because if element (c) is considered with element (f), there would be no vagueness.

Question 3

This question related to preparing an information disclosure statement. It added to the fact situation of question 2, a coinventor's prior use and reduction to practice of the invention in the United States. The examinees were asked if they would modify the disclosure statement and explain either a "yes" or "no" answer.

The grader gave no credit for this 20 point question which petitioner answered by indicating that there was no need to change the information disclosure statement. The only comment the grader made was that the inventions were not assigned at the time of Smith's U.S. trip so that it would be prior art under 35 USC 102(g)/103 as to Wisdom's invention. On review, the Director awarded partial credit of 2 points for petitioner's discussion of why there was no material prior art under 35 USC 102(b).

Petitioner argues that the relevant date for determining the applicability of the common ownership prior art exclusion under 35 USC 103 is the date when the Wisdom invention was made and not the date of the making of the Smith invention. Since at the time the Wisdom invention was made in the United States, the inventions were commonly owned, Smith's trip would not be prior art as to the Wisdom invention and so it does not have to be disclosed to the PTO. Petitioner also argues that there is no prior knowledge under 35 USC 102(a) which must be disclosed because it was not public.

DECISION

Question 1

A thorough and detailed review of the entire record indicates that too many points were deducted for this question. It is concluded that there is antecedent basis in the claim for the term "the unhinged end" and also that "side walls" is a definite term. However, the Director was correct in his assessment that petitioner's description of the handle was vague and that this deficiency was not cured by the subsequent language in element (f). Accordingly, only 3 points will be added to petitioner's score for this question.

Question 3

A thorough and detailed review of the entire record indicates that additional partial credit should have been awarded for petitioner's answer to this question. In particular, his discussion about the common ownership issue under 35 USC 103 deserves partial credit of 2 points out of

a total of the four assigned to this issue by the model answer. It should be noted that the common ownership prior art exclusion in section 103 is limited to 35 USC 102(f) and (g) and therefore does not apply to 102(a) prior art. Further, the exclusion is not limited to the date the invention was made in the United States as assumed by petitioner.

The Director did not err in refusing to award full credit because petitioner's answer did not indicate that the information disclosure statement should be revised to include Smith's trip as prior knowledge or use under 35 USC 102(a) and the circumstances of the separate reductions of practice of the two species inventions. The non-secret use of the Smith invention by Smith would be prior art as to the Wisdom invention under sections 102(a)/103 even though it would not be an absolute bar under section 102(b).

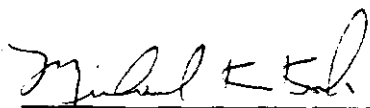
Accordingly, only two points will be added to petitioner's score for this question.

CONCLUSION

The Director's decision of March 31, 1988 is reversed to the extent of restoring five points deducted by the Director from petitioner's score in the afternoon section of the examination on October 6, 1987. Petitioner, accordingly, has achieved a passing score of 70 points or more in the afternoon section.

The petition is granted.

Dated: 6/20/88



MICHAEL K. KIRK
Assistant Commissioner
for External Affairs